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One World Trade Center
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121 S.W. Salmon Street
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EXAMINER

HAAS, WENDY C

ART UNIT	PAPER NUMBER
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1661

DATE MAILED: 12/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

DETAILED ACTION*Comments*

Applicant argues that a rejection based on public use or sale outside this country is an improper rejection under 35 U.S.C. § 102(b). The present rejection is not based on public use or sale outside this country; it is based on the printed publication cited. Applicant's admission of an offer for sale in a foreign country is provided as extrinsic evidence that the cited publication is enabled because a person of ordinary skill in the art would have access to the starting materials needed to make and use the invention (i.e. the claimed plant.)

Applicant further argues that to be in possession of the claimed plant, one of ordinary skill in the art would need to sexually re-create the plant, and that Elsner is wrongly decided. The Examiner is bound under *stare decisis* by the decision of the Court of Appeals for the Federal Circuit made in Elsner, regardless of whether or not applicant feels the decision is correct.

These arguments are deemed unpersuasive, as the first argument does not apply to the rejection of record. The Examiner has no authority to reconsider the Elsner decision, as requested by the second argument.

Under Elsner, the Office must show the following facts and/or evidence in order to establish a *prima facie* case of unpatentability under 35 U.S.C. § 102(b) based on a publication disclosing the claimed plant made more than one year prior to the filing date of application for patent in the United States:

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1. A publication disclosing the claimed plant published more than one year prior to the effective filing date of the United States application for patent. Elsner, 381 F.3d at 1129;
2. Public possession of the claimed plant more than one year prior to the effective filing date of the United States application for patent. *Id.* at 1130. Public possession is defined as “availability known in the art” rather than “an obscure, solitary occurrence.” *Id.* at 1131;
3. Reproducibility of the claimed plant by a person of ordinary skill in the art without undue experimentation. *Id.*

The present facts raise a question as to whether the availability of the claimed plant in Germany more than one year prior to the effective filing date of the instant application falls under the scope of “availability known in the art” or would better be defined as “an obscure, solitary occurrence.” As such, the Examiner is issuing a Requirement for Information Under Rule 1.105 regarding the scope of availability of the claimed plant.

Rule 105 Requirement for Information

Applicant and the assignee of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application.

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The information is required to determine when, the claimed plant variety, 'KORPANCOM', was publicly available prior to the filing date of the instant application.

The claimed rose plant 'KORPANCOM' is described in the German Plant Breeder's Right documents of record, each published more than one year prior to the effective filing date of the instant application. The information is a form of public notice. Thus, the public was aware of the instant plant more than one-year prior to the filing date of this instant application.

Given this information, the application is a printed publication under the guidelines set forth in *In re Wyer*. See *In re Wyer*, 655 F.2d 221,226,210 USPQ 790,794 (CCPA 1981). See also MPEP § 2128. The Plant Breeder's Right application is enabled if the disclosed cultivar could have been propagated from publicly available materials. One skilled in the art would have the knowledge of how to do so, given the notoriety of various methods of asexual propagation.

A printed publication can serve as a statutory bar under 35 U.S.C. 102(b) if the reference, combined with knowledge in the prior art, would enable one of ordinary skill in the art to reproduce the claimed plant. *In re Le Grice*, 301 F.2d 929,133 USPQ 365 (CCPA 1962). If one skilled in the art could obtain or reproduce the plant from a publicly available source, then a publication describing the plant would have an enabling disclosure. See *Ex parte Thomson*, 24 USPQ2d 1618, 1620 (Bd. Pat. App. & Inter. 1992) ("The issue is not whether

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the [claimed] cultivar Siokra was on public use or sale in the United States but, rather, whether 'Siokra' seeds were available to a skilled artisan anywhere in the world such that he/she could attain them and make/reproduce the cultivar Siokra disclosed in the cited publications.”).

The publication cited above discloses the claimed variety. However, a question remains as to the accessibility of any foreign sales or public availability of the claimed plant, and whether one of ordinary skill in the art would have known of any foreign sale or public availability. The foreign sale or public availability must not be an obscure, solitary occurrence that would go unnoticed by those skilled in the art.

Applicant and the assignee of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application.

The information is required to determine whether the accessibility of any foreign sales or public availability of the claimed plant more than one year prior to the effective filing date of this application.

In response to this requirement please provide:

a) information available regarding the first sale or other public distribution of the claimed plant variety anywhere in the world, including the date(s) and location of any sale or other

public distribution including any public information available regarding sales, offers for sale, or public distributions of the claimed plant variety that occurred more than one year prior to the effective filing date of this application, including information pertaining to whether this was an obscure, solitary occurrence that would go unnoticed by those skilled in the art,

b) a copy of any publications or advertisements relating to sales, offers for sale, or public distributions of the claimed plant variety anywhere in the world if the sale, offer for sale, or public distribution occurred more than one year prior to the effective filing date of this application;

c) any information relating to the accessibility or non-accessibility of the claimed plant that one of ordinary skill in the art could have derived from the printed PBR document or other sources;

The fee and certification requirements of 37 CFR 1.97 are waived for those documents submitted in reply to this requirement. This waiver extends only to those documents within the scope of this requirement under 37 CFR 1.105 that are included in the applicant's first complete communication responding to this requirement. Any supplemental replies subsequent to the first communication responding to this requirement and any information disclosures beyond the scope of this requirement under 37 CFR 1.105 are subject to the fee and certification requirements of 37 CFR 1.97.

The applicant is reminded that the reply to this requirement must be made with candor and good faith under 37 CFR 1.56. If an item required by the examiner is unknown to the

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applicant, a statement that the item is unknown to applicant will be accepted as a complete response to the requirement for that item. Where the applicant does not have and cannot readily obtain an item of required information, a statement that the item cannot be readily obtained will be accepted as a complete response to the requirement for that item.

The time period for reply to this requirement is 2 months. This requirement is subject to the provisions of 37 CFR 1.134, 1.135 and 1.136. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

A handwritten signature in black ink, appearing to read "W. C. Haas", written in a cursive style.

W. C. Haas
Patent Examiner
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